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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/964,962

09/27/2001

Craig Paulsen

IGT1P267/P-577

2536

79646

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07/06/2009

Weaver Austin Villeneuve & Sampson LLP - IGT

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

07/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/964,962	Applicant(s) PAULSEN	
	Examiner M. Sager	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-60 and 63-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-60 and 63-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed 2/3/06 entered new matter regarding ‘addressable pixels’(clms 27, 33, 37, 72), ‘programmed to receive from a remote device programming instructions or information for changing the game play indicia available on the gaming apparatus’ (claims 32, 37, 44 and 77), ‘themed’ (clms 41-43 and 76), ‘a theme’ (claim 57, 59 and 83) and ‘related to one or more of a particular casino, a game played on a gaming apparatus a location or an event’ (claims 58, 60 and 84) that is not adequately supported by originally filed written description that conveys to an artisan at time of filing that Applicant possessed the claimed invention. In addition, although, the cited amendment states in part that Applicant believes the claim amendments add no new matter, no specific support for the amended language was provided and contrary to Applicant opine in cited amendment on page 12 element 48 pertains to integrated circuits (page 5, line 27) rather than to alleged addressable pixels. There is no support in original specification regarding addressable pixels as claimed. Applicant admission that addressable pixels is acknowledged, but the fact of such technology being available prior to instant application is not evidence as to being disclosed, suggested or taught by original specification. Further, although there was agreement as indicated on interview summary for interview conducted on 10 July 2006 that paragraph 23 of PG Pub 2003/0060269 suggests a remote device, there is no teaching or suggestion that a remote device programs game indicia on

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gaming apparatus as presently claimed. For instance, although paragraph 23 states in part 'the I/O circuit 88 may be adapted to receive a number of signals which may allow a programmer to change the information stored within RAMS(s) 86 and/or ROM(s) 82 and therefore vary the game play' there is no teaching or suggestion that the change pertains to game play indicia stored in RAM and/or ROM since the change may be changing pay out of pay table based on time of play so as to encourage wagering/gaming during off-peak hours or change wager limits (min/max), change speed of rotation or any other facet stored in RAMs/ROMs although no particular facet including change game play indicia is specifically disclosed to put public in possession of what Applicant invented regarding the remote device and such programming game indicia by remote device is not inherent nor implied. In essence, the original disclosure does not provide adequate support to convey to an artisan that Applicant possessed the invention regarding a remote device to program a gaming machine as claimed or as alleged by Counsel/Applicant since the sending of signals received by I/O circuit 88 to change information in RAM(s) 86 and/or ROM(s) 82 lacks specificity as to what the signals pertain or what information is being changed in RAMs/ROMs. The Office acknowledges remote programming of computer as a gaming device was known to exist prior to instant application; however, the Applicant is reminded of their duty to disclose their invention at time of filing so as to place the public in possession of what they invented. The Applicant failed to follow this requirement in this application since the signals and information is not defined to place the public in possession as to what they pertain in manner that defines what the programmer is doing and certainly not in manner claimed. Also, no player/casino selection of game(s) from a list of games is disclosed such that there is no teaching for player/casino selection of a game from a plurality of games

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including bonus or secondary game(s) so as to change indicia based on different game selected or reprogramming of gaming machine to provide a different game or symbol set based on selected game from a plurality of games since no such selection is disclosed.

Also, the cited amendment added new matter regarding 'a theme', 'themed' and 'related to one or more of a particular casino, a game played on a gaming apparatus a location or an event' since no teaching or discussion is evident in originally filed specification that conveys to an artisan at time of filing that Applicant possessed the invention regarding claimed function.

Although prior action conveyed that specification did not support reprogramming of game play indicia, the action may not have been clear that this was considered new matter; hence, the proper emphasis herein. In addition, the facet regarding theme appears inter-related to reprogramming game play indicia based on theme, location or event that clearly is not disclosed in specification so as to notify public that this forms part of invention.

Applicant is required to cancel the new matter in reply to this Office Action.

2. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel rebuttal is provided below and incorporated herein. Where the [paraphrased] claimed 'cause said indicium to be displayed', 'displaying the indicium', storing programming instruction or information for generating the game play indicia including the indicium and determine the game play indicia (or similar language) includes displaying an infinite number of indicia or selection/determination

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from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicia or storing instructions or information for generating the game play indicia so as to generate a list of infinite number of symbols to select the indicia, the original filed specification does not enable the claimed invention with respect to displaying an infinite number of indicia or display indicia determined from an infinite number of symbols' or storing instructions or information for generating the game play indicia that is generating from an infinite number of indicia. To clarify so as to be clear, the issue is with respect to form of invention claimed and disclosed that includes an infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or information to generate the game play indicia from an infinite number of indicia and/or determining/selecting from an infinite number of indicia for display (again, memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicium for selection). The original specification (especially paragraphs 18 and 26), as best understood, appears to require either displaying an infinite number of display symbols (indicia) or selecting/determining from a infinite number of symbols to display selected or determined symbol(s); however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium where it is generating a list of an infinite number of symbols or determination/selection from an infinite number of symbols is not enabled.

3. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel remark is provided below and incorporated herein. The original filed specification, including drawings and claims, fails to reasonably convey to an artisan that Applicant had possession of claimed invention at time of filing regarding 'cause said indicium to be displayed', 'displaying the indicium', 'instruct the display driver to display the game play indicia', and select/determine game play indicia in so far as such displaying, determination or storing includes displaying an infinite number of indicium or selection from an infinite number of symbols (pg pub 20030060269, abstract and paragraphs 18 and 26) to display the selected indicium or to select indicia from infinite number of symbols since the original filed specification does not reasonably convey to an artisan that the Applicant possessed the invention with respect to displaying an infinite number of indicium or display indicium selected or determined from an infinite number of symbols. In looking to scope of claimed steps, the Applicant's original filed specification discloses infinite number of indicia or symbols (abstract, paragraph 18, 26); however, there is no such obtainable value, no processor capable of processing that many symbols, no memory capable of storing that many symbols and no display that can display that many symbols due to processor, memory and display being of finite capability/capacity. To clarify so as to be clear, the issue is with respect to the written specification fails to reasonably convey to an artisan that the Applicant possessed the invention regarding an infinite number of indicia either being displayed (a display is of limited space and thus cannot by extension contain an infinite number of elements), storing instructions or

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information to generate the game play indicia from an infinite number of indicia and/or select/determine the indicia to display an infinite number of indicia for display (memory and/or processing capacity is limited/finite and thus by extension cannot be infinite so as to either store an infinite number of indicia for selection or process an infinite number of indicia for selection).

The original specification (abstract, paragraphs 18 and 26), as best understood, discloses displaying an infinite number of display symbols (indicia) or storing instruction for generating the game play indicia including the indicium that is to select or determine from an infinite number of indicia; however, display, memory and processing is finite and thus such displaying of an infinite number of symbols or storing instructions or information for generating the game play indicia including the indicium where it is generating a list of an infinite number of symbols or selection from an infinite number of symbols is not demonstrated as being possessed.

4. Claims 27-60 and 63-86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This holding is maintained from prior action as reiterated herein. Response to Applicant/Counsel assertions is provided below and incorporated herein.

The cited claims are indefinite since it is unclear how an infinite number of indicia are displayed or how indicium are selected/determined from an infinite number of indicia or how the gaming apparatus stores an infinite number of indicium for selection/determination at least since the display, memory and controller are each finite in capability, but the claimed indicia/indicium pertains to an infinite number of indicia and infinite is indefinite.

Response to Arguments

5. Applicant's arguments filed June 18, 2009 have been fully considered but they are not persuasive. Regarding assertion that Applicant/Counsel believes that the claims add new matter as stated on page 12 (first sentence of second paragraph), the Office agrees as in evidence above incorporated herein. Also, contrary to Applicant remark on page 13 that the amendment has overcome the 112 first paragraph and second paragraph, the Office disagrees as maintained from paragraphs 3-6 and 9 of prior action [paragraph 9 of prior action is incorporated herein] and as reiterated in evidence above since to be clear, the originally filed specification includes a form (abstract, paragraph 18 and 26 of PG PUB 2003/0060269) that displays an infinite number of different indicia, a processor that determines indicia to display from an infinite number of symbols that Applicant has not shown as being in possession due to no display can display an infinite number of symbols, no processor can select/determine from an infinite number of symbols and no memory can store an infinite number of symbols from which a processor selects/determines which indicia to display due to each being of finite capacity as stated in evidence above incorporated herein. The Applicant has not provided factual evidence that they possessed invention regarding a processor having infinite capacity to determine indicia from an infinite number of indicia, a display having capability to display an infinite number of symbols or a memory having infinite storage to store an infinite number of symbols.

Also, the Office has not applied art due to no known processor, memory or display can process to select/determine, display or store an infinite number of indicia.

6. Applicant's arguments with respect to claims 27-60 and 63-86 have been considered but are moot in view of the new ground(s) of rejection. Finally, steps vii) to xii) of amendment to

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claim 27 appears redundant to steps i) - vi) and similar redundancy is evident in claims 33, 37, and 72.

Conclusion

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/
Primary Examiner, Art Unit 3714